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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,371	06/19/2000	Philip J. Keller	E0889	3850

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EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
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2154

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DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/597,371

Applicant(s)  
Philip J. Keller et al.

Examiner  
Bharat Barot

Art Unit  
2154



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 19, 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 02 6) ☐ Other:

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## **DETAILED ACTION**

### **Specification**

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### **Drawings**

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### **Claim Rejections - 35 USC § 103(a)**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng (U.S. Patent No. 6,571,291) in view of Chow (U.S. Patent No. 6,459,705).

5. As to claim 1, Cheng teaches a method of communicating within a network interface apparatus (abstract and summary of the invention), comprising: creating special frames in a first part of the apparatus, the special frames including an identifier that distinguishes them from other frames passing through the apparatus (figure 1; and column 3 lines 38-50); sending the special frames from the first part to a second part of the apparatus through at least a media access controller of the device, the second part including a physical layer device (figure 2; and column 3 line 27 to column 4 line 2); and identifying the special frames from among frames incoming to the second part, the identifying including examining the incoming frames for the presence of the identifier (figure 2; and column 3 line 51 to column 4 line 14).

However, Cheng does not explicitly teach the step of: extracting physical layer device control information from the special frames at the second part.

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Chow explicitly teaches the steps of: sending the special frames from the first part to a second part of the apparatus through at least a media access controller of the device; identifying the special frames from among frames incoming to the second part the identifying including examining the incoming frames for the presence of the identifier; and extracting physical layer device control information from the special frames at the second part (abstract; figures 1-3; column 3 lines 21-36; column 3 line 62 to column 4 line 28; and column 4 lines 35-61)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Chow as stated above with the method of communicating within a network interface apparatus of Cheng because it would have increased the internal processing speed to improved the network latency.

6. As to claims 2-3, Cheng teaches that the creating includes creating the special frames with the identifier in the position of a destination address, and wherein the identifying includes examining destination addresses of the incoming frames (column 4 lines 30-39); and the identifier is an otherwise unused IEEE address (column 1 lines 17-23; and column 3 lines 27-37).

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7. As to claims 4-5, Chow teaches that the controlling the physical layer device using the control information; and the extracting the control information includes changing the contents of memory registers of the second part (abstract; column 3 lines 21-36; column 4 line 29 to column 5 line 27; and column 6 lines 15-43).

8. As to claims 6-7, Cheng teaches that the first part includes an intermediate driver capable of creating the special frames; and the sending the special frames includes passing the special frames through a device driver (column 3 line 38 to column 4 line 14; and column 7 line 64 to column 8 line 61).

9. As to claim 8, Chow teaches that the creating additional special frames in the second part, the additional special frames including an additional identifier, and passing the additional special frames to the first part (abstract; figure 3; and column 4 lines 5-28 and 35-61).

10. As to claims 9-10, Chow teaches that the the identifier and the additional identifier are in the form of destination addresses; and the identifier and the additional identifier are the same (column 3 lines 21-35; and column 4 lines 62-64).

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11. As to claims 11-20, they are also rejected for the same reasons set forth to rejecting claims 1-4 and 6-10 above, since claims 11-20 are merely an apparatus for the method of operation defined in the method claims 1-4 and 6-10. Additionally, Cheng teaches that the special frames are formatted to pass through the second media access controller as if the special frames were data frames (column 3 line 38 to column 4 line 14; and column 7 line 64 to column 8 line 61).

12. As to claims 21-25, they are also rejected for the same reasons set forth to rejecting claims 1-2, 4, 6-10, and 14 above, since claims 21-25 are merely an apparatus for the method of operation defined in the method claims 12, 4, and 6-10.

#### **Additional References**

13. The following references are cited by the examiner as of general interest.
- a. Dwork et al, U.S. Patent No. 6,581,113.
  - b. Shim, U.S. Patent No. 6,088,723.

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**Contact Information**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose telephone number is **(703) 305-4092**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **An, Meng-Ai**, can be reached at **(703) 305-9678**. The fax phone numbers for examiner's Art Unit OR Group are **After final response (703) 746-7238, Official response (703) 746-7239, and Unofficial/Draft response (703) 746-7240**.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is **(703) 305-3900**.

Patent Examiner Bharat Barot

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August 26, 2003

*Bharat Barot.*  
**BHARAT BAROT**  
**PRIMARY EXAMINER**